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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte XM WONG and ROCK TAO

Appeal 2010-005098
Application 09/741,684
Technology Center 2600

Before TERRY J. OWENS, JOSEPH F. RUGGIERO, and ERIC B. CHEN,
Administrative Patent Judges.

RUGGIERO, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 19-24, which are all of the pending claims. Claims 1-18 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Appeal Brief (filed Aug. 24, 2009, the Answer (mailed Nov. 23, 2009), and the Reply Brief (filed Jan. 25, 2010).

Appellants' Invention

Appellants' invention relates to a suspension and slider assembly for a magnetic recording head in which a bonding substance is heated prior to being applied as a surface finishing material to a metal bonding pad of the suspension. A slider bonding pad, which initially has no bonding substance, is coupled to the suspension by the reflowing of the bonding substance on the suspension bonding pad, thereby coupling the suspension bonding pad to the slider bonding pad. Reuse of the suspension is enabled by removing the connection with the slider bonding pad with heat treatment. *See generally* Spec. 4:1-4.

Claim 19 is illustrative of the invention and reads as follows:

19. A suspension comprising:

a suspension bonding pad for electrically bonding a magnetic head terminal, wherein said bonding pad includes a metal pad having a bonding substance applied as a surface finishing material, the surface finishing material being heat treated prior to bonding to a surface; and a slider bonding pad initially without bonding substance coupled to said suspension such that the bonding substance on said suspension bonding pad is reflowed so as to electrically couple the suspension bonding pad and the slider bonding pad, wherein the slider bonding pad enables the reuse of the suspension by removing the connection between a slider and the slider bonding pad with heat treatment, and further wherein a plurality of traces extend longitudinally generally along the center of a suspension and extend along the lateral edges of a slider to a trailing edge of the slider.

The Examiner's Rejections¹

The Examiner relies on the following prior art reference to show unpatentability:

Albrecht	US 5,821,494	Oct. 13, 1998
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Claims 19-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Albrecht.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Albrecht.

ANALYSIS

35 U.S.C. § 102(b) REJECTION

Appellants argue, with respect to independent claim 19, that Albrecht does not disclose a plurality of traces which extend *along* the lateral edges of a slider as claimed. According to Appellants (App. Br. 5), the trace connections 74a of Albrecht extend along the outside of the suspension 44 and *away* from the lateral edges of the slider 42 (Fig. 21A-21C).

We do not agree with Appellants as we find that Appellants' disclosure is totally devoid of any support for the interpretation of the "along the lateral edges of the slider" claim recitation urged by Appellants in the Briefs. Appellants argue that Albrecht's traces do not extend *along* the lateral edges of the slider since they are spaced apart from the outer edges of the slider, i.e., there is a distance between the traces and the outer lateral edges of the slider (Reply Br. 2-4).

¹ The Examiner has withdrawn the 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 112, second paragraph, rejections of claims 19-24 (Ans. 3).

Appellants' arguments imply that the claim language "along the lateral edges of a slider" must be interpreted as meaning that the traces must be *on* the slider, an arrangement for which there is no support in Appellants' disclosure. To the contrary, the only description of Appellants' claimed trace arrangement appears in the Figure 1 illustration which depicts the traces spaced apart from the lateral edges of the slider. Accordingly, even though Albrecht's traces 74 are spaced apart from the lateral edges of slider 42, we find no error in the Examiner's interpretation (Ans. 4) of such arrangement as corresponding to the claimed "along the lateral edges of the slider" since such interpretation comports with the trace arrangement described by Appellants in their disclosure.

In view of the above discussion, we find that the Examiner did not err in concluding that all of the limitations of independent claim 19 are present in the disclosure of Albrecht. Accordingly, the Examiner's 35 U.S.C. § 102(b) rejection of independent claim 19, as well as the rejection of dependent claims 20-23 not separately argued by Appellants, is sustained.

35 U.S.C. § 103(a) REJECTION

We also sustain the Examiner's obviousness rejection, based on Albrecht, of dependent claim 24. We find no error in the Examiner's determination (Ans. 4-5) that the claimed values for solder bump height and diameter would have been arrived at through routine experimentation and optimization. While the Examiner's stated rejection relies only on Albrecht, Appellants' arguments in the Appeal Brief are directed solely to an Ainslie reference (U.S. Pat. No. 4,761,699), which is not part of the Examiner's stated rejection.

Lastly, we recognize that Appellants have provided arguments directed to the merits of the Examiner's reliance on Albrecht to reject claim 24 at pages 4 and 5 of the Reply Brief. Since these arguments were presented for the first time on appeal in the Reply Brief, they are therefore deemed to be waived. *See Ex parte Borden*, 93 USPQ2d 1473, 1473-74 (BPAI 2010) ("informative"²) (absent a showing of good cause, the Board is not required to address an argument newly presented in the Reply Brief that could have been presented in the principal Brief on Appeal).

CONCLUSION

Based on the analysis above, we conclude that the Examiner did not err in rejecting claims 19-23 for anticipation under 35 U.S.C. § 102(b), and rejecting claim 24 for obviousness under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision rejecting claims 19-24 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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² Designated as "Informative Opinion" at <http://www.uspto.gov/ip/boards/bpai/decisions/inform/index.jsp>.